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09/994,309	11/26/2001	Thomas Birkhoelzer	P01,0469	8682

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/994,309
Filing Date: November 26, 2001
Appellant(s): BIRKHOELZER ET AL.

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EXAMINER'S ANSWER

This is in response to the appeal brief filed April 15, 2004.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

The appellant's statement in the brief that certain claims do not stand or fall together is not agreed with because Appellant's representative sets forth a single grouping of claims asserting that all claims, 1-6, stand or fall together. However, claims 1-6 should be presented in three groups each related to separate grounds of rejection as acknowledged and set forth in the

Issues section of the Brief. The groupings corresponding to the grounds of rejection should properly place claims 1-4 in a first group, which stand or fall together, claim 5 in a second group, and claim 6 in a third group. In this fashion, each grouping will have a claim that is representative of the ground of rejection for the group. Appellant's representative properly sets forth separate arguments for each grouping.

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

6,427,063	Cook et al	7-2002
6,301,571	Tatsuoka	10-2001
6,371,765	Wall et al	4-2002

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4 are rejected under 35 U.S.C. 102(e) as being anticipated by Cook et al (US 6,427,063 B1).

Regarding claim 1, Cook et al discloses a system and method in which an input device is configured to receive an entry from a training participant, a data bank in which a plurality of training modules with and without dependencies upon one another and the dependencies being stored in the data bank also, and a selection device to combine a number of the modules, based upon dependency, into a generated training unit (Col 5, lines 41-65, Col 6, lines 1-16).

Regarding claim 2, Cook et al discloses a system and method wherein in the training modules are generated with a uniform level of expert knowledge (Col 5, lines 54-56).

Regarding claim 3, Cook et al discloses a system and method in which content may be a prerequisite for the generation of other modules and these constraints are taken into account when generating a training unit (Col 5, lines 45-65).

Regarding claim 4, Cook et al discloses an apparatus with the capability of responding to request entries from the student and generate the next level of training unit based upon the worded request (Col 11, lines 5-24).

Claim 6 is rejected under 35 U.S.C. 102(e) as being anticipated by Wall et al (US 6,371,765). Wall et al discloses a training method for automatically determining and meeting the training needs of training participants comprising entering the learning objectives, background knowledge and requested topic of the learning needs of a training participant (Col 4, lines 22-57), determining all training all modules responsive to a user's entry (Col 5, lines 15-25), identifying selected training modules dependent upon a user's background knowledge and defining a training unit customized to a user from the multiple training modules previously identified (Col 5, lines 41-67).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cook et al in view of Tatsuoka (US 6,301,571 B1). Cook et al does not specifically disclose that the data bank contains a plurality of medical education training modules. However, Tatsuoka teaches that an important aspect of building a combination of modules for training is in the diagnosis and training participants in their treatment of medical conditions (Col 30, lines 33-64). Therefore it would have been obvious to one of ordinary skill in the art at the time of invention to provide an apparatus with a data bank that contains a plurality of medical education training modules. Combining the system disclosed by Cook et al with the teaching of Tatsuoka produces a dynamic training system that builds training regimens for participants based upon the individual characteristics of the participant.

(11) Response to Argument

Appellant begins his presentation with the position that the Cook et al reference provides a training program configuration is designed for a particular trainee or student but does not provide a recitation of a customized training program in which training modules are not composed of stored entities that are in themselves stored training modules. In addition, Appellant presents the argument that Cook et al does not anticipate training modules that are combined or linked with other stored training modules based upon dependencies between the training modules. Finally, the Appellant presents the argument that there is no disclosure or teaching in the Wall et all reference of a training method for automatically determining and meeting the needs of training participants producing an automatic culling and combining procedure in the selection of a training module.

Appellants do acknowledge that the Tatsuoka reference teaches undertaking a continually updated diagnosis of participants in training programs for treating medical conditions, which is the teaching for which this reference was cited.

With regard to the argument that the stored training modules recited in the Cook et al reference are not themselves composed of component training modules, the Examiner relies upon the teaching in Cook et al that training modules are presented to a student through the use of a plurality of persona that are on-screen software agents (Col 5, lines 25-33) which have access to instructional modules and are customized to individual student behaviors and preferences such that the on-screen personae select those training modules most relevant to each student based upon the dependencies of preferences stored with the training modules (Col 5,

lines 42-53). Each such training module is composed of data snips created by artists, animators, singers and so forth (Col 5, lines 55-56) to build data modules to be used in the composition of an on-screen agent, and, most importantly, that these data snips can consist of complete pre-formatted animated sequences (Col 5, lines 63-65) presenting information to a student. The Cook et al reference teaches that the on-screen agent is, therefore, a construct built by combining pre-formatted sequences that are in themselves complete lesson modules. Thus, the Cook et al reference does recite the storage and display of a training module, the on-screen agent, that is composed of sub-modules that are, in themselves, complete training modules and, therefore, anticipates claims 1-4 and renders claim 5, in combination with the Tatsuoka reference, obvious.

With regard to the argument that the Cook et al reference does not teach storing teaching modules with dependencies, Cook et al recites the fact that the lesson modules stored in the training system are composed of materials for the display of training modules including information containing the substance of the instruction, logic to sequence the display according to student input, and notations concerning definitions that serve to pass information to the on-screen agent concerning the materials and the student (Col 6, lines 35-41). Thus, the Cook et al reference does teach storing teaching modules with dependencies that define how teaching modules are interrelated and anticipates Appellant's claims 1-4.

With regard to the argument that there is no disclosure or teaching in the Wall et all reference of a training method for automatically determining and meeting the needs of training participants producing an automatic culling and combining procedure in the selection of a training module, the Examiner would like to respectfully point out that Appellant's claims do not recite a training method for *automatically* determining and meeting the needs of training

participants. Appellant's claim 6 recites the limitations for a search engine that may be used by a student to identify and recall stored training modules from a database of such elements. The Wall et al reference recites a similar function by providing a number of prompts to assist a user in locating and recalling training modules of interest (Col 5). Thus, the Wall et al reference does anticipate Appellant's claim 6.

As can be seen, the examiner has provided a proper prima facia case of anticipation and obviousness denying patentability of the presented claims.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

John L. Sotomayor

Examiner AU 3714

jls
July 8, 2004

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